

ESTTA Tracking number: **ESTTA719626**

Filing date: **01/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	PIKLIST LLC
Granted to Date of previous extension	01/10/2016
Address	249 Smith Street Brooklyn, NY 11231 UNITED STATES
Attorney information	Joseph T. Nabor, Alisa C. Simmons Fitch Even Tabin & Flannery LLP 120 S. LaSalle Street, Suite 1600 Chicago, IL 60603 UNITED STATES trademark@fitcheven.com, asimmons@fitcheven.com Phone:312-577-7000

### Applicant Information

Application No	86283507	Publication date	07/14/2015
Opposition Filing Date	01/11/2016	Opposition Period Ends	01/10/2016
Applicant	Pikmobile, Inc. 6020 Autumn Oaks Lane Naples, FL 34114 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Downloadable computer application software and cloud software for the collection, editing, organizing, modifying, transmission, storage, sharing and managing electronic media and information with others and enables users to upload, download, access post, display, tag, blog, stream, link, or otherwise provide electronic media and information via global computer networks, mobile telephones, and other communications networks

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86393009	Application Date	09/12/2014
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	PIKLIST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/09/00 First Use In Commerce: 2011/09/00 Downloadable software program for use in design and managing content on a website Class 042. First use: First Use: 2011/09/00 First Use In Commerce: 2011/09/00 Software solutions, namely providing use of on-line non-downloadable software for use in enabling internet publishing		

Attachments	86393009#TMSN.png( bytes ) Notice of Oppositon to PIKLIST by Pikmobile.pdf(82174 bytes ) Exhibit A to Notice of Opposition.pdf(117999 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Alisa C. Simmons/
Name	Alisa C. Simmons
Date	01/11/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PIKLIST LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
Pikmobile, Inc.	)	
	)	
Applicant.	)	
<hr style="width:25%; margin-left:0;"/>	)	
Serial No.: 86283507	)	
Filed: May 16, 2014	)	
Mark: PIKLIST	)	
Published: July 14, 2015	)	

NOTICE OF OPPOSITION

PIKLIST LLC, a New York limited liability company, located and doing business at 249 Smith Street, #199, Brooklyn, New York 11231 United States (“Piklist”), believes that it will be damaged by registration of the PIKLIST trademark Application No. 86283507 for goods in Class 9, and hereby opposes the same on the following grounds:

COUNT I - TRADEMARK LIKELIHOOD OF CONFUSION

1. Piklist designs and provides software products and services for website design, creation, development, and management and for internet and online publishing and blogging, along with other software programs and software solutions.
2. In Application Serial No. 86283507, filed on May 16, 2014, Pikmobile, Inc. (“Applicant”), is seeking to obtain registration on the Principal Register for the mark PIKLIST for use on “Downloadable computer application software and cloud software for the collection, editing, organizing, modifying, transmission, storage, sharing and managing electronic media and information with others and enables users to upload, download, access post, display, tag, blog, stream, link, or otherwise provide electronic media and information via global computer networks, mobile telephones, and other communications networks.”

3. Commencing prior to Applicant's filing date, Piklist has been engaged in and continues to be engaged in the manufacture, distribution, sale, advertising and promotion of software products and services for website design, creation, development, and management and for internet and online publishing and blogging, along with other software products and related services, under the mark PIKLIST in the U.S.

4. Piklist began using the mark PIKLIST at least as early as September 2011, in connection with software products and related services for website design, creation, development, and management and for internet and online publishing and blogging in the United States.

5. Based on its longstanding and continuous use of the PIKLIST mark, Piklist filed on September 12, 2014, Application Serial No. 86393009 to register its PIKLIST with the United States Patent & Trademark Office ("USPTO") for use on "Downloadable software program for use in design and managing content on a website," in International Class 9 and "Software solutions, namely providing use of on-line non-downloadable software for use in enabling internet publishing," in International Class 42. A current printout of information from the USPTO electronic database records showing the current status and title information from the USPTO website is attached as Exhibit A.

6. During the examination of Piklist's Application Serial No. 86393009, the USPTO Examining Attorney has cited the Applicant's Application Serial No. 86283507 as a potential Section 2(d) bar to the registration of Piklist's PIKLIST mark.

7. Long prior to Applicant's adoption and use of the PIKLIST mark on computer application software and cloud software, Piklist was actively engaged in interstate and foreign commerce in the business of manufacturing, sale, distributing and advertising of software products and related services for website design, creation, development, and management and for internet and online publishing and blogging bearing the PIKLIST trademark.

8. Piklist has expended a significant amount in developing and in advertising and promoting its PIKLIST mark and products and services, and has distributed a significant amount of products and services bearing the PIKLIST mark in the United States. As a result of

such efforts and expenditures, as well as the high quality of its goods, the PIKLIST mark has come to represent extremely valuable goodwill to Piklist.

9. On information and belief, Applicant's adoption of the PIKLIST trademark on computer application software and cloud software is with full knowledge of Piklist's use of the PIKLIST mark, at the time that the Applicant filed Application No. 86283507 for registration of the PIKLIST mark for such software products.

10. On information and belief, the earliest date of actual or constructive use of the PIKLIST mark for the goods specified in the subject application upon which the Applicant can rely is May 16, 2014, the filing date of the subject application.

11. Piklist's priority in its PIKLIST mark is earlier than any priority that the Applicant can establish in its PIKLIST mark.

12. On information and belief, Applicant's alleged adoption and use of the applied-for PIKLIST mark for the applied-for computer application software and cloud software has been without the consent or permission of Piklist.

13. On information and belief, the specified goods for which the Applicant seeks registration of the PIKLIST mark in Application Serial No. 86283507 are similar and/or closely related to the goods that Piklist offers in connection with its PIKLIST mark.

14. On information and belief, the goods for which the Applicant seeks registration of the PIKLIST mark in Application Serial No. 86283507 are likely to be marketed to the same or related customers and through the same or related channels of trade in which Piklist provides its goods and services in connection with its PIKLIST mark.

15. The Applicant's PIKLIST mark is confusingly similar to Piklist's PIKLIST mark.

16. Based on the foregoing, Applicant's intended adoption, use, distribution, offer for sale, and sale of computer application software and cloud software bearing the PIKLIST mark are likely to cause confusion, mistake or deception as to the origin of the goods among the relevant consuming public such that the public is likely to believe that Applicant's products originate

with Piklist, are licensed by Piklist, or are sponsored, authorized, endorsed, or are otherwise related to Piklist.

17. If the Applicant is granted registration of its PIKLIST mark as shown in Application No. 86283507, the Applicant will thereby obtain the *prima facie* exclusive right to use the PIKLIST mark on downloadable computer application software and cloud software for the collection, editing, organizing, modifying, transmission, storage, sharing and managing electronic media and information with others and enables users to upload, download, access post, display, tag, blog, stream, link, or otherwise provide electronic media and information via global computer networks, mobile telephones, and other communications networks, and such registration of the PIKLIST mark will impair, diminish, and dilute Piklist's goodwill and rights in its PIKLIST mark causing irreparable injury to Piklist.

#### COUNT II - FEDERAL TRADEMARK DILUTION

18. Piklist re-alleges and incorporates by reference the allegations of paragraphs numbered 1-17.

19. Piklist has expended substantial monies in marketing, advertising and promoting its PIKLIST mark on its goods and services.

20. Piklist possesses extremely valuable goodwill in the PIKLIST mark by reason of its extensive use, marketing, publicity, advertising and geographic extent of its use and promotion. This goodwill was established long prior to the filing of Applicant's Application Serial No. 86283507.

21. Piklist has distributed a significant amount of goods and services bearing the PIKLIST mark.

22. The PIKLIST mark is famous and distinctive within the meaning of the Lanham Act, and are entitled to the protection of the anti-dilution provisions of the Lanham Act, including 15 U.S.C. § 1125(c).

23. Applicant filed the Application No. 86283507 after the PIKLIST mark became famous and distinctive.

24. If Applicant is granted registration of PIKLIST as set forth in Application No. 86283507, Applicant will thereby obtain the prima facie exclusive right to use such mark, and such registration will damage, impair, tarnish, diminish, and dilute the distinctive quality of Piklist's PIKLIST mark.

PRAYER FOR RELIEF

WHEREFORE, Piklist prays that this Opposition be sustained, that Application No. 86283507 be rejected, and that registration of the PIKLIST mark for the goods specified therein be refused.

Date: January 11, 2016

Respectfully submitted,

By: s/Alisa C. Simmons/  
Joseph T. Nabor  
Alisa C. Simmons  
Fitch, Even, Tabin & Flannery, LLP  
120 South LaSalle Street, Suite 1600  
Chicago, Illinois 60603  
Telephone: (312) 577-7000

*Attorneys for Opposer*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

NOLAND J. CHEUNG  
COHEN & GRIGSBY, P.C.  
625 LIBERTY AVE FL 7  
PITTSBURGH, PENNSYLVANIA 15222-3152

on this 11th day of January, 2016.

FITCH, EVEN, TABIN & FLANNERY LLP

s/Alisa Simmons/  
\_\_\_\_\_  
Joseph T. Nabor  
Alisa C. Simmons  
FITCH, EVEN, TABIN & FLANNERY LLP  
120 South LaSalle, Suite 1600  
Chicago, Illinois 60603  
Telephone 312.577.7000  
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*Attorneys for Opposer*



# **Exhibit A**

**Generated on:**

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**Mark:** PIKLIST

# PIKLIST

**US Serial Number:** 86393009

**Application Filing Date:**

Sep. 12, 2014

**Register:**

Principal

**Mark Type:**

Trademark, Service Mark

**Status:**

An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

**Status Date:**

Jul. 16, 2015

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## Mark Information

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**Mark Literal Elements:**

PIKLIST

**Standard Character Claim:**

Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:**

4 - STANDARD CHARACTER MARK

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:**

Downloadable software program for use in design and managing content on a website

**International Class(es):** 009 - Primary Class

**U.S Class(es):**

021, 023, 026, 036, 038

**Class Status:**

ACTIVE

**Basis:**

1(a)

**First Use:** Sep. 2011

**Use in Commerce:**

Sep. 2011

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**For:**

Software solutions, namely providing use of on-line non-downloadable software for use in enabling internet publishing

**International Class(es):** 042 - Primary Class

**U.S Class(es):**

100, 101

**Class Status:**

ACTIVE

**Basis:**

1(a)

**First Use:** Sep. 2011

**Use in Commerce:**

Sep. 2011

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## Basis Information (Case Level)

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Filed Use: Yes  
Filed ITU: No  
Filed 44D: No  
Filed 44E: No  
Filed 66A: No  
Filed No Basis: No

Currently Use: Yes  
Currently ITU: No  
Currently 44D: No  
Currently 44E: No  
Currently 66A: No  
Currently No Basis: No

Amended Use: No  
Amended ITU: No  
Amended 44D: No  
Amended 44E: No

## Current Owner(s) Information

**Owner Name:**

Piklist, LLC

**Owner Address:**

249 Smith Street #199  
Brooklyn, NEW YORK 11231  
UNITED STATES

**Legal Entity Type:** LIMITED LIABILITY COMPANY

**State or Country Where  
Organized:**

NEW YORK

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** John Naber

**Docket Number:**

20275-133653

**Attorney Primary Email  
Address:** [trademark@fitcheven.com](mailto:trademark@fitcheven.com)

**Attorney Email  
Authorized:**

Yes

### Correspondent

**Correspondent  
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**Correspondent e-mail  
Authorized:**

Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Jul. 16, 2015	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Jul. 16, 2015	LETTER OF SUSPENSION E-MAILED	6332
Jul. 16, 2015	SUSPENSION LETTER WRITTEN	82087
Dec. 27, 2014	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Dec. 27, 2014	LETTER OF SUSPENSION E-MAILED	6332
Dec. 27, 2014	SUSPENSION LETTER WRITTEN	82087
Dec. 27, 2014	ASSIGNED TO EXAMINER	82087
Sep. 20, 2014	NOTICE OF PSEUDO MARK E-MAILED	
Sep. 19, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 16, 2014	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information

**TM Attorney:** HENRY, NAKIA D

**Law Office Assigned:**

LAW OFFICE 117

### File Location

**Current Location:** LAW OFFICE 117 - EXAMINING ATTORNEY  
ASSIGNED

**Date in Location:**  
Jul. 16, 2015



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**No assignment has been recorded at the USPTO**

**For Serial Number: 86393009**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.5  
Web interface last modified: July 25, 2014 v.2.5

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